

REMARKS

Applicant has amended claims 1, 4, and 8 to more particularly point out and distinctly claim the subject matter which they regard as their own invention. No new matter has been introduced by the amendments. Claim 13 has been withdrawn from further consideration as it is drawn to non-elected subject matter.

Claims 1-12 and 14 are under examination. Reconsideration of this application, as amended, is requested in view of the following remarks.

Rejection under 35 U.S.C. 112, second paragraph

Claims 1-12 and 14 are rejected for indefiniteness. The Examiner specifically points out that the terms "first layer," "second layer," and "third layer," and "substance" recited in these claims are indefinite. See the Office Action, page 2, line 19 through page 3, line 7. To rectify the defects, Applicant has amended claims 1, 4, and 8 as suggested by the Examiner.

Rejection under 35 U.S.C. 112, first paragraph

Claims 1-12 and 14 are also rejected for lack of enablement.

Claims 1-12 are drawn to a catalyst having a rhodium catalyst layer, a zeolite layer, and a palladium catalyst layer. Claim 14 is drawn to a catalyst system containing such a catalyst.

The Examiner asserts that "the specification, while being enabling for the claimed composition wherein both rhodium and palladium are dispersed in a refractory inorganic powder, does not reasonably provide enablement for the claims wherein only rhodium and palladium are recited as components of the layers." See the Office Action, page 3, lines 15-18. She further contends that "[a]lthough the specification contains language such as that claimed, i.e., the first layer contains at least rhodium; it is very clear from a reading of the specification that rhodium and platinum are always dispersed in a refractory inorganic powder." See the Office Action, page 3, lines 20-23. The Examiner obviously takes the position that, for the catalyst of claims 1-12 and the catalyst system of claim 14, it is critical that rhodium and palladium be dispersed in refractory inorganic powder. She appears to rely on the example provided in the specification,

which shows a catalyst having a layer in which rhodium is dispersed in a refractory inorganic powder (i.e., alumina), a zeolite layer, and a layer in which palladium is dispersed in a refractory inorganic powder (i.e., alumina). See page 9, line 15 through page 10, line 19.

Applicant would like to point out that the specification describes a catalyst having a rhodium catalyst layer, a zeolite layer, and a palladium catalyst layer. See page 2, line 20 through page 3, line 2. It is clear from this description that refractory inorganic powder can be absent from the catalyst. Indeed, as stated in the specification, refractory inorganic powder merely serves as a support that carries rhodium or palladium. See page 4, lines 1-15. Rhodium and palladium can exert the asserted catalytic effect in the absence of a support or in the presence of a support other than refractory inorganic powder. It follows that rhodium or palladium dispersed in refractory inorganic powder is not a critical feature. At most, it is a preferred feature for the claimed catalyst.¹ In this connection, Applicant would like to point out that

“Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention for function as intended.” MPEP 2164.08(c) (emphasis added).

As discussed above, the language of the specification makes it clear that using refractory inorganic powder is not critical. Rather, it indicates that refractory inorganic powder can be omitted. Thus, in view of the above-quoted MPEP statement, Applicant respectfully submits that this rejection should be withdrawn.

CONCLUSION

For the reasons set forth above, claims 1-12 and 14, as pending, cover definite and enabled subject matter. Further, according to the Examiner, these claims also cover subject

¹ According to MPEP 2164.08(c), “[f]eatures which are merely preferred are not to be considered critical.”

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matter that is novel and non-obvious over the prior art. See the Office Action, page 4, lines 1-9.

Applicant therefore requests that the Examiner promptly allow these claims.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Y. Rocky Tsao
Y. Rocky Tsao, Ph.D., J.D.,
Attorney for Applicant
Reg. No. 34,053

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906